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Takatoshi Hirose

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EXAMINER

MURRAY, DANIEL C

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,174	<b>Applicant(s)</b> HIROSE, TAKATOSHI	
	<b>Examiner</b> DANIEL C. MURRAY	<b>Art Unit</b> 2443	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12MAR2010, 08APR2010</u>                                      | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on 27JAN2010. **Claims 1, 3-11, 13, and 14** are now pending in the present application. **This Action is made FINAL.**

### *Information Disclosure Statement*

2. The information disclosure statements submitted on 12MAR2010 and 08APR2010 have been considered by the Examiner and made of record in the application.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 11** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claim 11** rejected under 35 USC 101 since the claims are directed to non-statutory subject matter. **Claim 11** recite a computer-readable storage medium which appears to cover both transitory and non-transitory embodiments. The United States Patent and Trademark Office (USPTO) is required to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory

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tangible media **and** transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim **must** be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

The Examiner suggests that the Applicant add the limitation “non-transitory computer-readable storage medium” to the claim(s) in order to properly render the claims in statutory form in view of their broadest reasonable interpretation in light of the originally filed specification. The Examiner also suggests that the specification be amended to include the term “non-transitory computer-readable storage medium” to avoid a potential objection to the specification for a lack of antecedent basis of the claimed terminology.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 1, 3, 6-11, and 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Asoh et al. (US Patent Publication # US 2004/0003060 A1)** in view of **Ohta (US Patent Publication # US 2001/0029531 A1)**.

a) Consider **claims 1, 10, and 11**, Asoh et al. clearly show and disclose, a connection control method for an information processing apparatus, information processing apparatus, and a computer-readable storage program product comprising a computer usable medium having computer-readable program codes control logic stored therein that, when executed by a computer, for causing a computer to control a connection of an information processing apparatus, wherein the control logic causes the computer to implement the method comprising: a reception step of receiving identification information for identifying a first wireless network and a second wireless network (figure 4, figure 10, abstract, paragraph [0012], [0013], [0014], [0015]); a first joining step of wirelessly joining the first wireless network identified by the identification information received in the reception step (figure 4, figure 10, abstract, paragraph [0012], [0013], [0014], [0015]); and a second joining step of wirelessly joining the second wireless network identified by the identification information received in the reception step (figure 4, figure 10, abstract, paragraph [0012], [0013], [0014], [0015], [0020], [0023]). However, Asoh et al. does not specifically disclose a first inquiry step of inquiring, of one or more information processing apparatuses in the first wireless network, whether the one or more information processing apparatuses have a function of performing print processing; a first detection step of detecting, if one or more positive responses to the inquiring in the first inquiry step are received, detecting one or more information processing apparatuses having

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the function of performing the print processing in the first wireless network; a first request step of requesting the print processing from at least one of the one or more information processing apparatuses in the first wireless network having the function of performing the print processing, if one or more the information processing apparatuses have the function of performing the print processing in the first wireless network are detected in the first detection step; a second inquiry step of inquiring, of one or more information processing apparatuses in the second wireless network, whether the one or more information processing apparatuses have the function of performing the print processing, if no information processing apparatus having the function of performing the print processing in the first wireless network is detected in the first detection step or the print processing cannot be performed by any of the information processing apparatuses requested to perform the print processing in the first request step; a second detection step of, if one or more positive responses to the inquiring in the second inquiry step are received, detecting one or more information processing apparatuses having the function of performing the print processing in the second wireless network; or a second request step of requesting the print processing from at least one information processing apparatus in the second wireless network having the function of performing the print processing, if no information processing apparatuses having the function of performing the print processing in the first wireless network is detected in the first detection step, wherein the first wireless network is different from the second wireless network or the print processing cannot be performed by any of the information processing apparatuses requesting to perform the print processing in the first request step.

Ohta shows and discloses printing at a convenient location, and more particularly related to a system for and method of printing information at a conveniently located printer station that is selected in a predetermined area wherein, Ohta clearly discloses a first inquiry step of inquiring, of

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one or more information processing apparatuses in the first wireless network, whether the one or more information processing apparatuses have a function of performing print processing (figure 13, abstract, paragraph [0007], [0039], [0040], [0053]); a first detection step of detecting, if one or more positive responses to the inquiring in the first inquiry step are received, detecting one or more information processing apparatuses having the function of performing the print processing in the first wireless network (figure 13, abstract, paragraph [0007], [0039], [0040], [0053], [0056]); a first request step of requesting the print processing from at least one of the one or more information processing apparatuses in the first wireless network having the function of performing the print processing, if one or more the information processing apparatuses have the function of performing the print processing in the first wireless network are detected in the first detection step (figure 13, abstract, paragraph [0007], [0040], [0053]); a second inquiry step of inquiring, of one or more information processing apparatuses in the second wireless network (figure 13, abstract, paragraph [0007], [0039], [0040], [0053]), whether the one or more information processing apparatuses have the function of performing the print processing, if no information processing apparatus having the function of performing the print processing in the first wireless network is detected in the first detection step (figure 13, abstract, paragraph [0007], [0040], [0053]) or the print processing cannot be performed by any of the information processing apparatuses requested to perform the print processing in the first request step (figure 13, abstract, paragraph [0007], [0040], [0053]); a second detection step of, if one or more positive responses to the inquiring in the second inquiry step are received, detecting one or more information processing apparatuses having the function of performing the print processing in the second wireless network (figure 13, abstract, paragraph [0007], [0039], [0040], [0053], [0056]); and a second request step of requesting the print processing from at least one information processing apparatus in the second wireless network having the

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function of performing the print processing, if no information processing apparatuses having the function of performing the print processing in the first wireless network is detected in the first detection step (figure 13, abstract, paragraph [0007], [0040], [0053]), wherein the first wireless network is different from the second wireless network or the print processing cannot be performed by any of the information processing apparatuses requesting to perform the print processing in the first request step (figure 13, abstract, paragraph [0007], [0040], [0053]).

One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Ohta and Asoh et al. since both concern detection over wireless networks and as such, both are with in the same environment.

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate detecting a device on network capable of performing a predetermined process, as taught by, Ohta into the system of Asoh et al. for the purpose of locating a printer on a wireless network capable of performing a predetermined process (Ohta; abstract), thereby allowing the user to conveniently locate a device on the network of performing a predetermined process.

b) Consider **claim 3**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, wherein, in the first request step, the print processing is requested from another information processing apparatus that has first positively responded to the inquiring in the first inquiry step (Ohta; abstract, paragraph [0045]).

c) Consider **claim 6**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, wherein in the first inquiry step, an inquiry is made whether all information processing apparatuses in the first wireless network have the function of performing print processing (Ohta; abstract, paragraph [0045]).



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d) Consider **claim 7**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, wherein the information processing apparatus wirelessly communicates according to a wireless LAN method defined by IEEE 802.11 (paragraph [0082]).

e) Consider **claim 8**, and **as applied to claim 7 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 7, wherein the information processing apparatus wirelessly communicates in a communication mode according to an infrastructure mode defined by IEEE 802.11 (paragraph [0082]).

f) Consider **claim 9**, and **as applied to claim 7 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 7, wherein the information processing apparatus wirelessly communicates in a communication mode according to an ad-hoc mode defined by IEEE 802.11 (paragraph [0082]).

g) Consider **claim 13**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, wherein in the first request step, at least one of the one or more information processing apparatuses having the function of performing the print processing is connected and the print processing is requested (Ohta; figure 13, abstract, paragraph [0007], [0040], [0045], [0053]).

h) Consider **claim 14**, and **as applied to claim 13 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 13, wherein in the first request step, the print processing requested from an information processing apparatus that has positively responded to the inquiring in the first inquiry step (Ohta; figure 13, abstract, paragraph [0007], [0040], [0045], [0053]).

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7. **Claims 4 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Asoh et al. (US Patent Publication # US 2004/0003060 A1)** in view of **Ohta (US Patent Publication # US 2001/0029531 A1)** and in further view of **Suda et al. (US Patent # 6,157,465)**.

a) Consider **claim 4**, and **as applied to claim 3 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 3. However, Asoh et al. as modified by Ohta does not specifically disclose in the first request step, if the print processing performed by an information processing apparatus that has first positively responded to the inquiring in the first inquiry step ends as an error, the print processing is requested from another information processing apparatus that has positively responded to the inquiring in the first inquiry step.

Suda et al. show and disclose a printer that is instructed to perform a printing job analyzes the job and determines a process to be executed, and identifies the performances of the printer and other printers and their states. Based on the results of the analysis and on the states of the printers, the printer decides whether it should not perform a process or whether the process should be performed by another printer. It also decides whether a process is unnecessary or is not permitted for a user, and halts the performance of such a process. When it determines that a process should be performed by another printer, it transfers the job to that printer, wherein in the first request step, if the print processing performed by an information processing apparatus that has first positively responded to the inquiring in the first inquiry step ends as an error, the print processing is requested from another information processing apparatus that has positively responded to the inquiring in the first inquiry step (column 20 lines 41-60, column 21 lines 27-37).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Suda et al. into the system of Asoh et al. as

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modified by Ohta et al. for the purpose of transferring a job to another device if an error occurs in the device originally executing the job.

b) Consider **claim 5**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1. However, Asoh et al. as modified by Ohta does not specifically disclose in the first inquiry step, if each response to the inquiring is a negative response or no response exists, a determination is made that there is no information processing apparatus having the function of performing the print processing in the first wireless network.

Suda et al. show and disclose a printer that is instructed to perform a printing job analyzes the job and determines a process to be executed, and identifies the performances of the printer and other printers and their states. Based on the results of the analysis and on the states of the printers, the printer decides whether it should not perform a process or whether the process should be performed by another printer. It also decides whether a process is unnecessary or is not permitted for a user, and halts the performance of such a process. When it determines that a process should be performed by another printer, it transfers the job to that printer, wherein in the first inquiry step, if each response to the inquiring is a negative response or no response exists, a determination is made that there is no information processing apparatus having the function of performing the print processing in the first wireless network (abstract, column 19 lines 52-64, column 20 lines 41-60).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Suda et al. into the system of Asoh et al. as modified by Ohta et al. for the purpose of locating a device capable of performing a predetermined process.

***Response to Arguments***

8. Applicant's arguments filed 27JAN2010 have been fully considered but they are not persuasive.

Applicant argues that "... the computer in *Asob et al.* does not inquire of apparatuses on any network whether the apparatuses have a function of performing print processing."

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). *Asob* was not cited as teaching this particular feature. *Ohta* clearly teaches inquiring of apparatuses on any network whether the apparatuses have a function of performing print processing (figure 13, abstract, paragraph [0007], [0039], [0040], [0053]). Furthermore, it is also clearly that Applicant is aware of this as these sections are referenced by Applicant (page 16 lines 14-18 and page 17 lines 5-11) from *Ohta* (paragraph [0039], [0040], [0053]) in the response dated 27JAN2010. *Ohta* clearly discloses the print notice signal includes information on a requester, a desired destination printer type, printing parameters as well as a print data pointer (*Ohta*; paragraph [0039] and as referenced by Applicant on page 16 lines 14 and 15) and upon receiving the print notice signal, the portable digital device 11 commences a printer search process by transmitting a first wireless signal. For example, the first wireless signal transmits only within 10 meters according to Class 3 of the BlueTooth transmission protocol and allows a scan and discovery of printers in a limited area (*Ohta*; paragraph [0040] and as referenced by Applicant page 16 lines 16-18). *Ohta* clearly discloses searching (inquiring) on a network for a desired destination printer type and printing parameters (apparatuses that have a function of performing print processing).

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Ohta also clearly discloses in response to the e-mail print notice, the portable digital device now searches an appropriate print station by broadcasting a wireless signal in the vicinity in a step 3. The appropriate print station is determined by a number of criteria including the location of the print station in relation to the portable digital device 11 and the print parameters that are provided in the e-mail print notice. The print parameters include a type of printing such as color, a speed of the printer and a number of copies. When the portable digital device 11 finds no appropriate print station, the preferred process ends after returning a signal indicative of finding no print station to the print server 13. On the other hand, when a desired print station is found, the portable digital device 11 transmits a print request signal to the selected print station in a step 5 (Ohta; paragraph [0053] and as referenced by Applicant page 17 lines 5-11). Here, Ohta also clearly discloses searching (inquiring) on a network for an appropriate print station (apparatuses that have a function of performing print processing) which is determined by a number of criteria including the location of the print station in relation to the portable digital device 11 and the print parameters.

Ohta clearly discloses searching/discovery (inquiring) of printer stations (apparatuses) on any network whether the printer stations (apparatuses) are the appropriate print station (apparatuses that have a function of performing print processing).

Therefore, Ohta clearly discloses inquiring of apparatuses on any network whether the apparatuses have a function of performing print processing.

Applicant argues “The portable digital device 11 is not understood to inquire of a printer station on the wireless network whether the printer station has a function of performing print processing. Instead, the portable digital device 11 is understood to use the first wireless signal to inquire of a printer station whether the printer station currently is operating on the wireless network.”

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The Examiner respectfully disagrees; Ohta clearly discloses inquiring of a printer station on the wireless network whether the printer station has a function of performing print processing (as discussed in detail above)(figure 13, abstract, paragraph [0007], [0039], [0040], [0053]). Furthermore, Applicant's statement "that the portable digital device 11 is understood to use the first wireless signal to inquire of a printer station whether the printer station currently is operating on the wireless network" appears to over simplify/misunderstand the teachings of Ohta. Ohta does not merely determine only whether the print station is currently operating on the wireless network with the first wireless signal. The portable digital device 11 commences a printer search process by transmitting a first wireless signal. For example, the first wireless signal transmits only within 10 meters according to Class 3 of the BlueTooth transmission protocol and allows a scan and discovery of printers in a limited area and although the positional relationship is used as one selection factor in this example, a print type and other print parameters are also used as equally important or deciding selection factors in other examples (paragraph [0040]). Ohta clearly discloses that not only does that the portable digital device 11 use the first wireless signal to inquire of a printer station whether the printer station currently is operating on the wireless network but also to determine which print stations currently operating on the network are capable of performing particular print processing functions (e.g. selection factors include a print type and other print parameters). Therefore, Ohta clearly discloses inquiring of a printer station on the wireless network whether the printer station has a function of performing print processing.

Furthermore, during the interview on 24MAR2010 Applicant requested clarification with respect to the Ohta reference and its interpretation, particularly whether the first wireless signal in Ohta returned more information regarding print station than just location data. The Applicant was directed to paragraphs [0055] and [0056] which disclose the information regarding print station

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capabilities/status that are included in the first wireless signal in addition to location data which is used in determining the appropriate print station.

Applicant argues “Moreover, nothing has been found in *Asoh et al.* that teaches or suggests that, if no computer inquired of on a first wireless network (*e.g.*, the home network) has a function of performing print processing or if the print processing cannot be completed by any computer requested to perform the print processing on the first wireless network, the computer joins a second wireless network (*e.g.*, the office network) and requests the print processing from an apparatus on the second wireless network.” and “... nothing in *Ohta* teaches or suggests that, if no printer station in a first wireless network has a function of performing print processing or if the print processing cannot be completed by any printer station on the first wireless network, the portable digital device 11 joins a second wireless network and requests the print processing from a printer station on the second wireless network.”

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The rejection of Applicant's claims is based on the combination of *Asoh* and *Ohta*.

See **MPEP 2143** Examples of Basic Requirements of a Prima Facie Case of Obviousness

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of

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obviousness as laid down in *Graham*. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.

Rationales that may support a conclusion of obviousness include (A) combining prior art elements according to known methods to yield predictable results.

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

*Asoh* teaches a system provided with a location profile for storing adapter information, which is physical change information corresponding to location information, and network configuration information, which is logical change information corresponding to this adapter information; an adapter changing device for changing an adapter to another according to the adapter information received from the location profile according to a specified location received from the user; and a network configuration updating device for updating a network configuration according to the network configuration information received from the location profile according to the received specified location. FIG. 6 shows display screen examples in those steps 103 and 104 (*Asoh*; abstract). In FIG. 6, the wireless adapter is selected for the category (connection type) and a list of network adapters 20 usable in the location are displayed. In this example, only one adapter 20 is displayed in the list. (*Asoh*; paragraph [0068])(see also; figure 4, figure 10, figure 12A, figure 15,



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paragraph [0012], [0020], [0023], [0067]). Asoh clearly shows a list of networks being provided to a user and that the user is able to choose among the available networks.

Ohta teaches a remote printing system allows one user to ultimately send a hard copy to another via a portable digital device such as a cellular phone. Upon receiving an e-mail print notice, the portable digital device wirelessly searches an appropriate print station in the vicinity by broadcasting a signal. In response to the broadcasted search signal, the print stations each send information on their printer characteristics such as availability status and print resolution to the portable digital device, a print server or a client that originated the print request. The recipient of the printer characteristic information selects an appropriate print station based upon a predetermined selection rule (Ohta; abstract)(see also; figure 13, paragraph [0007], [0039], [0040], [0053], [0055], and [0056]).

Asoh clearly teaches the aspects of Applicant's invention relating to the detection of multiple networks and network selection and Ohta clearly teaches the aspects of Applicant's invention relating to the discovery and selection of a particular printing apparatus on a network.

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately.

One of ordinary skill in the art could have combined the teaching of Asoh with the teaching of Ohta such that in combination, each element merely performs the same function as it does separately. It would have been obvious to one of ordinary skill in the art that teaching of Ohta relating to the search of a network for a particular printing apparatus could have been combined with the teachings of Asoh relating to the detection of multiple networks and network selection, such that multiple networks could be detected and a network selected as taught by Asoh then the

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selected network could be searched for a particular printing apparatus as taught by Ohta. Each element of both Asoh and Ohta would perform the same function as they do separately in combination.

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable.

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1395; Sakraida v. AG Pro, Inc., 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); Anderson 's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

It would have been obvious to one that the combination of Asoh and Ohta were predictable and that one of ordinary skill in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yield nothing more than predictable results. It would have been obvious to one of ordinary skill in the art to detect and select from multiple networks as taught by Asoh and to search a network for a device capable of performing a specific function as taught by Ohta. Furthermore it would have been obvious to one of ordinary skill in the art that the teaching of Ohta could be combined with those of Asoh yielding predictable results with no change in their respective function.

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It would have been obvious to one of ordinary skill in the art to detect multiple networks and select a first network from a list of detected networks as taught by Asoh. Once selected it would have been obvious to one of ordinary skill in the art to then search that first network for a device capable of performing a specified function as taught by Ohta. Should there be no devices on the first network discovered capable of performing the specified function (a situation disclosed in Ohta) it would have been obvious to one of ordinary skill in the art to search a second network selected from the list of networks in the same manner as the first network for a device capable of performing a specified function.

For example if one were to use teaching of Ohta to search for a color printer (a function of performing print processing) on a first network (e.g. the home network) that was selected from a list of detected networks as taught by Asoh and was not able to detect an appropriate printer on the first network it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Asoh to select another network and search the second network (e.g. the office network, another home network, etc.) for an appropriate printer using the teachings of Ohta.

If one is searching for a particular item in one location and it is not there it is common sense for that person to then search in other places where the item may be located. For instance, if one was searching for a set of car keys in the bedroom and did not find them would they just stop searching or would they be more likely to move to the next likely location, say the living room, and search for them there? Given the ability of a user to detect and select a network from a group of networks (Asoh) and the ability to search a network for a printer having a particular capability (function)(Ohta) it would have been obvious for a user, not finding what they were looking for in one location to simply search another location where the printer may be found. Therefore, it would

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have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Asoh and Ohta to search multiple networks for a printer having a capability/function as one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the Applicant, in preparing the responses, to fully consider each of the cited references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage disclosed by the Examiner.

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With respect to any amendments to the claimed invention, it is respectfully requested that Applicant indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

If Applicant intends to make numerous amendments the Examiner respectfully requests that Applicant submit a clean copy of the claims in addition to the marked up copy of the claims in order to expedite the examination process.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL C. MURRAY whose telephone number is 571-270-1773. The examiner can normally be reached on Monday - Friday 0800-1700 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on (571)-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. C. M./  
Examiner, Art Unit 2443

/Tonia LM Dollinger/  
Supervisory Patent Examiner, Art Unit 2443